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**To:** U.S. Patent & Trademark Office  
**Attention:** Resubmission of  
Documents for Scanning

**From:** Stephen Macevicz  
**Phone:** (650) 210-1223  
**Fax:** (650) 210-9271

**Fax:** (703) 872-9306

**Pages:** \_\_\_\_ including this cover sheet-

**Phone:**

**Date:** 04 December 2003

**Re:** U.S. Patent Application  
Serial No. 09/824,851  
Filed 02 April 2001

Group Art Unit: 1637  
Examiner: J. Tung

Attorney Reference: 033.11US

Dear Sir or Madam:

Attached is a duplicate set of the following documents:

Submission of a Terminal Disclaimer, Terminal Disclaimer to Obviate a Provisional Double Patenting, Transmittal and Fee Transmittal.

These forms were originally transmitted and received by Examiner Tung on 24 November 2003. Examiner Tung has requested that these documents be resubmitted to the above fax number for the purpose of scanning them into the PTO system.

Please call me if you have any questions or need any further clarification regarding the above referenced patent application and the resubmission of these documents at (650) 210-1223 (Direct).

Sincerely,

A handwritten signature in black ink, appearing to read "Stephen C. Macevicz".

Stephen C. Macevicz,  
Registration No. 30,285  
Attorney for Applicants

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DEC 04 2003

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:

  
Virginia Griffith

24 November 2003

Pages transmitted (incl cover): 4  
Destination FAX number: (703) 746-5184

Case No. 033.11 (0225-0033.26)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Singh

Serial No: 09/824,851

Filed: 02 April 2001

For: KITS EMPLOYING GENERALIZED  
TARGET-BINDING E-TAG PROBES

Examiner: J. Tung

Art Unit: 1637

**Submission of Terminal Disclaimer**

Assistant Commissioner of Patents  
Washington, D. C. 20231

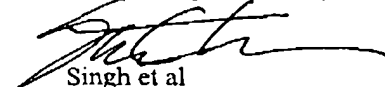
Sir:

In a telephone interview of 24 November 2003, the Examiner stated that the present application would be allowable upon submission of a Terminal Disclaimer with respect to application Ser. No. 09/825,244. Applicants have agreed to submit such a Terminal Disclaimer, which is submitted herewith.

In view of the above, Applicants submit that the claims as written fully satisfy the requirements of Title 35 of the U.S. Code, and respectfully request that the rejections thereunder be withdrawn and that the claims be allowed and the application quickly passed to issue.

If any additional time extensions are required, such time extensions are hereby requested. If any additional fees not submitted with this response are required, please take such fees from deposit account 50-2266.

Respectfully submitted,



Singh et al

By Stephen C. Maccvitz

Reg. No. 30,285

Telephone: (650) 210-1223

PTO/SB/21 (08-03)

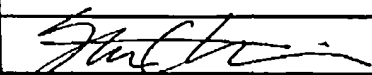
Approved for use through 07/31/2006. OMB 0851-0031


U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/824.851
	Filing Date	02 April 2003
	First Named Inventor	Singh
	Art Unit	1637
	Examiner Name	J. Tung
Total Number of Pages in This Submission	Attorney Docket Number	033.11US

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below). 1. Terminal Disclaimer 2. Return Receipt Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Stephen C. Macevitz, Registration No. 30,285
Signature	
Date	24 November 2003

CERTIFICATION OF FACSIMILE TRANSMISSION		
I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:		
 Virginia Griffith	24 November 2003 Date	Pages transmitted (incl cover): 4 Destination FAX number: (703) 746-5184

PTO/SB/25 (08-03)

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**TERMINAL DISCLAIMER TO OBIATE A PROVISIONAL DOUBLE  
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**Docket Number (Optional)  
033.011US

In re Application of: Sharat SINGH et al

Application No. 09/824,851

Filed: April 02, 2001

For: Kits Employing Generalized Target-Binding E-Tag Probes

The owner\*, **ACLARA BIOSCIENCES, INC.**, of 100% percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 09/825,244, filed on 02 April 2001, of any patent on the second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.


In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

 11/24/03  
Signature Date

Stephen C. Macevitz, Registration No. 30,285  
Typed or printed name

(650) 210-1223  
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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PTO/SB/17 (08-03)  
 Approved for use through 07/31/2008. OMB 0651-0032  
 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

<b>FEE TRANSMITTAL</b> <b>for FY 2003</b> Effective 01/01/2003. Patent fees are subject to annual revision.		Complete if Known	
		Application Number	09/824,851
		Filing Date	02 April 2001
		First Named Inventor	Sharat Singh
		Examiner Name	J. Tung
		Art Unit	1637
		Attorney Docket No.	033.11 US
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT		(\$)	
		\$55.00	

METHOD OF PAYMENT (check all that apply)		FEE CALCULATION (continued)																																																																																																																																																																																																																																																					
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Deposit Account Number: 50-2268 Deposit Account Name: ACLARA BIOSCIENCES, INC.		<table border="1"> <thead> <tr> <th>Large Entity</th> <th>Small Entity</th> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>1051</td> <td>130</td> <td>2051</td> <td>65</td> <td></td> <td></td> <td>Surcharge - late filing fee or oath</td> <td></td> </tr> <tr> <td>1052</td> <td>50</td> <td>2052</td> <td>25</td> <td></td> <td></td> <td>Surcharge - late provisional filing fee or cover sheet</td> <td></td> </tr> <tr> <td>1053</td> <td>130</td> <td>1053</td> <td>130</td> <td></td> <td></td> <td>Non-English specification</td> <td></td> </tr> <tr> <td>1812</td> <td>2,520</td> <td>1812</td> <td>2,520</td> <td></td> <td></td> <td>For filing a request for reexamination</td> <td></td> </tr> <tr> <td>1804</td> <td>920*</td> <td>1804</td> <td>920*</td> <td></td> <td></td> <td>Requesting publication of SIR prior to Examiner action</td> <td></td> </tr> <tr> <td>1805</td> <td>1,840*</td> <td>1805</td> <td>1,840*</td> <td></td> <td></td> <td>Requesting publication of SIR after Examiner action</td> <td></td> </tr> <tr> <td>1251</td> <td>110</td> <td>2251</td> <td>55</td> <td></td> <td></td> <td>Extension for reply within first month</td> <td></td> </tr> <tr> <td>1252</td> <td>410</td> <td>2252</td> <td>205</td> <td></td> <td></td> <td>Extension for reply within second month</td> <td></td> </tr> <tr> <td>1253</td> <td>830</td> <td>2253</td> <td>465</td> <td></td> <td></td> <td>Extension for reply within third month</td> <td></td> </tr> <tr> <td>1254</td> <td>1,450</td> <td>2254</td> <td>725</td> <td></td> <td></td> <td>Extension for reply within fourth month</td> <td></td> </tr> <tr> <td>1255</td> <td>1,970</td> <td>2255</td> <td>985</td> <td></td> <td></td> <td>Extension for reply within fifth month</td> <td></td> </tr> <tr> <td>1401</td> <td>320</td> <td>2401</td> <td>160</td> <td></td> <td></td> <td>Notice of Appeal</td> <td></td> </tr> <tr> <td>1402</td> <td>320</td> <td>2402</td> <td>160</td> <td></td> <td></td> <td>Filing a brief in support of an appeal</td> <td></td> </tr> <tr> <td>1403</td> <td>280</td> <td>2403</td> <td>140</td> <td></td> <td></td> <td>Request for oral hearing</td> <td></td> </tr> <tr> <td>1451</td> <td>1,510</td> <td>1451</td> <td>1,510</td> <td></td> <td></td> <td>Petition to institute a public use proceeding</td> <td></td> </tr> <tr> <td>1452</td> <td>110</td> <td>2452</td> <td>55</td> <td></td> <td></td> <td>Petition to revive - unavoidable</td> <td></td> </tr> <tr> <td>1453</td> <td>1,300</td> <td>2453</td> <td>650</td> <td></td> <td></td> <td>Petition to revive - unintentional</td> <td></td> </tr> <tr> <td>1501</td> <td>1,300</td> <td>2501</td> <td>650</td> <td></td> <td></td> <td>Utility issue fee (or reissue)</td> <td></td> </tr> <tr> <td>1502</td> <td>470</td> <td>2502</td> <td>235</td> <td></td> <td></td> <td>Design issue fee</td> <td></td> </tr> <tr> <td>1503</td> <td>630</td> <td>2503</td> <td>315</td> <td></td> <td></td> <td>Plant issue fee</td> <td></td> </tr> <tr> <td>1460</td> <td>130</td> <td>1460</td> <td>130</td> <td></td> <td></td> <td>Patents to the Commissioner</td> <td></td> </tr> <tr> <td>1807</td> <td>50</td> <td>1807</td> <td>50</td> <td></td> <td></td> <td>Processing fee under 37 CFR 1.17 (t)</td> <td></td> </tr> <tr> <td>1806</td> <td>180</td> <td>1806</td> <td>180</td> <td></td> <td></td> <td>Submission of Information Disclosure Sheet</td> <td></td> </tr> <tr> <td>8021</td> <td>40</td> <td>8021</td> <td>40</td> <td></td> <td></td> <td>Recording each patent assignment per property (times number of properties)</td> <td></td> </tr> <tr> <td>1808</td> <td>750</td> <td>2808</td> <td>375</td> <td></td> <td></td> <td>Filing a submission after final rejection (37 CFR § 1.128(a))</td> <td></td> </tr> <tr> <td>1810</td> <td>750</td> <td>2810</td> <td>375</td> <td></td> <td></td> <td>For each additional invention to be examined (37 CFR § 1.129(b))</td> <td></td> </tr> <tr> <td>1801</td> <td>750</td> <td>2801</td> <td>375</td> <td></td> <td></td> <td>Request for Continued Examination (RCE)</td> <td></td> </tr> <tr> <td>1802</td> <td>900</td> <td>1802</td> <td>900</td> <td></td> <td></td> <td>Request for expedited examination of a design application</td> <td></td> </tr> <tr> <td colspan="2">SUBTOTAL (1)</td> <td colspan="2">(\$) 0</td> </tr> <tr> <td colspan="2">         2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE          Total Claims: 20 ** = 0 X Fee from below = 0          Independent Claims: 3 ** = 0 X Fee from below = 0          Multiple Dependent: X Fee from below = 0       </td> <td colspan="2">         Other fee (specify) Statutory Disclaimer          *Reduced by Basic Filing Fee Paid          SUBTOTAL (3) (\$) 0       </td> </tr> <tr> <td colspan="2">         SUBTOTAL (2) (\$) 0          **or number previously paid, if greater, For Reissues, see above       </td> <td colspan="2">         SUBTOTAL (3) (\$) 0       </td> </tr> </tbody></table>		Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid	1051	130	2051	65			Surcharge - late filing fee or oath		1052	50	2052	25			Surcharge - late provisional filing fee or cover sheet		1053	130	1053	130			Non-English specification		1812	2,520	1812	2,520			For filing a request for reexamination		1804	920*	1804	920*			Requesting publication of SIR prior to Examiner action		1805	1,840*	1805	1,840*			Requesting publication of SIR after Examiner action		1251	110	2251	55			Extension for reply within first month		1252	410	2252	205			Extension for reply within second month		1253	830	2253	465			Extension for reply within third month		1254	1,450	2254	725			Extension for reply within fourth month		1255	1,970	2255	985			Extension for reply within fifth month		1401	320	2401	160			Notice of Appeal		1402	320	2402	160			Filing a brief in support of an appeal		1403	280	2403	140			Request for oral hearing		1451	1,510	1451	1,510			Petition to institute a public use proceeding		1452	110	2452	55			Petition to revive - unavoidable		1453	1,300	2453	650			Petition to revive - unintentional		1501	1,300	2501	650			Utility issue fee (or reissue)		1502	470	2502	235			Design issue fee		1503	630	2503	315			Plant issue fee		1460	130	1460	130			Patents to the Commissioner		1807	50	1807	50			Processing fee under 37 CFR 1.17 (t)		1806	180	1806	180			Submission of Information Disclosure Sheet		8021	40	8021	40			Recording each patent assignment per property (times number of properties)		1808	750	2808	375			Filing a submission after final rejection (37 CFR § 1.128(a))		1810	750	2810	375			For each additional invention to be examined (37 CFR § 1.129(b))		1801	750	2801	375			Request for Continued Examination (RCE)		1802	900	1802	900			Request for expedited examination of a design application		SUBTOTAL (1)		(\$) 0		2. 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SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	Stephen C. Macovicz	Registration No. (Attorney/Agent)	30,265
Signature		Telephone	(850) 210-1223
		Date	09 September 2003

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